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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,418	10/12/2001	David K. Harris	BROOKSTONE 00.15	9987

7590

08/01/2003

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175 Canal Street  
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EXAMINER
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LUONG, SHIAN TINH NHAN

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/976,418

Applicant(s)

HARRIS ET AL.

Examiner

Shian T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-25, 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 9-10, 12-18, 20-23, 28-29, 31-32 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US 2,274,196) in view of Cook (US 3,750,871). Gilbert discloses a transparent container 10 with two end caps 11. A merchandising card extends between the two caps. Although Gilbert does not show the card situated in the caps, Cook teaches two end caps 10,12 with recesses or cavities 16 configured in size and shape to receive therein the uppermost or lowermost portion or portions of contained item or items. The end caps stabilize the item and prevent unnecessary movement. The end caps also include flanges with grooves 29, 31 to accept the tube. It would therefore been obvious in view of Cook to provide the recesses or cavities in the end caps to stabilize the card in Gilbert. It would also have been obvious to one having ordinary skill in the art at the time the invention was made to make the tube out of thermoplastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Applicant's assertion that Gilbert does not teach a merchandising card is an error. Gilbert specifically teaches a merchandising card 17,28 in the container. The merchandising card has perforation 21 or scored hole 22 to provide anchorage for fastening contents of the container to the frame structure thereby keeping them arranged in an orderly relationship and preventing

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them from shaking loose or coming into contact with the surrounding tube. Just as element 14 or rod 14 extends into the caps, Cook teaches the conventional use of groove or grooves in a cap to secure any item within the container, including for example, a card. The examiner is not relying on the shape of Cook's grooves for the combination, but the basic idea of providing any shape for the grooves to allow engagement of the card with the cap. One of ordinary skill in the art would find the combination obvious to perform the above suggested function.

3. Claims 4-6 and 23-25 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 4, further in view of Jeffs et al. (US 5,711,446). Jeffs et al. Is only cited to show a typical tube with recesses and protrusions to engage the respective protrusions and recesses on an end cap. The structural engagement is a typical type of coupling device well known in the container art.

4. Claims 11 and 19, 30 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 1, further in view of Official Notice. It is well settled that the patentability of a product ordinarily can not depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985). Also note MPEP 706.03(e), In re Brown, 59 CCPA 1063, 173 USPQ 685 (CCPA 1972); In re Fessmann, 180 USPQ 324 (CCPA 1974) regarding the Office's lesser burden of proof in product-by-process claims. Hence, whether or not the end caps are molded does not distinguish the final product of the container. With respect to claim 19, it would be obvious to provide indicia on the merchandise card of Gilbert to illustrate the content within the tube.

5. Claims 21-22 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Cook. It would also have been obvious to one having ordinary skill in the art at the time the

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invention was made to make the tube out of transparent thermoplastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. Claims 23-25 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 20, further in view of Jeffs et al. (US 5,711,446). Jeffs et al. is only cited to show a typical tuber with recesses and protrusions to engage the respective protrusions and recesses on an end cap. The structural engagement is a typical type of coupling device well known in the container art.

7. Claim 30 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 20, further in view of Official Notice. It is well settled that the patentability of a product ordinarily can not depend on its method of being made. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (1985). Also note MPEP 706.03(e), *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (CCPA 1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974) regarding the Office's lesser burden of proof in product-by-process claims. Hence, whether or not the end caps are molded does not distinguish the final product of the container.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. The **Group clerical receptionist number is (703) 308-1148** or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.

For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302 and for After Final Amendment the number is (703) 872-9303. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

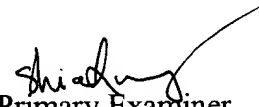
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Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (703) 308-2039. The examiner can normally be reached on T-F from 7:00am to 4:00pm EST.

STL  
July 31, 2003



Primary Examiner  
Shian Luong  
Art Unit 3728